

REMARKS

Claims 1 through 3, 5 through 8, 13 through 17, 27, 28, 30, 31, and 33 through 44 are pending in this Application. Claims 5 and 12 have been canceled without prejudice and disclaimer. Claims 1, 6 through 8, 27, 28, 30, 31, 35 through 38, and 40 through 42 have been amended, and new claims 43 and 44 have been added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the Abstract, FIG. 2, ¶¶ [0025] and [0037] of the corresponding US Pub. No. 2003/0005448. Applicants submit that the present Amendment does not generate any new matter issue.

Claim Objection.

The Examiner objected to claims 30, 31, and 42, identifying a perceived informality and courteously suggested remedial language. In response, the recitation of “mobile alter” in claims 30, 31, and 42 have been replaced by “mobile alert”, as suggested by the Examiner thereby overcoming the stated basis for the objection. Applicants therefore solicit withdrawal of the objection to claims 30, 31, and 42.

Claims 1, 2, 5 through 7, 12 through 17, 27, 28, 34, 38, and 39 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Ellis et al.* (US 20060031883, “*Ellis*”) in view of *Collins et al.* (US 6424828, “*Collins*”).

In the statement of the rejection the Examiner concluded that one having ordinary skill in the art would have been led to modify *Ellis*’s interactive TV program guide by including *Collins*’

mechanism for forwarding an SMS to a mobile handset, so that users can received notifications when they are not in proximity to their televisions. This rejection is traversed.

There are fundamental differences between the claimed inventions and the applied references that undermine the obviousness conclusion under 35 U.S.C. §103(a). Specifically, independent claims 1, 27, and 28 are directed to an apparatus that sends a notification of a content item (e.g., program) of interest, and recite, *inter alia*: “**scheduling** an alert message of said selected content item **to be transmitted as an SMS to a mobile handset at a time point that has a predetermined time period before the selected content item being available.**” Neither *Ellis* nor *Collins* discloses or suggests an apparatus, method, or computer storage medium having these features.

In contrast to the claimed inventions, *Ellis*’s programming reminder/alert is issued by the local or remote interactive television program guides and displayed on a TV device or the remote program guide access devices 24 (¶[0086]) **within the TV guide**, rather than embedded in a message sent to a mobile handset and displayed **within an email application**. *Collins* only transmits an alert SMS **on demand**, rather than being “**scheduled to be transmitted** as an SMS to a mobile handset **at a time point that has a predetermined time period before the selected content item being available.**” The prior art email alerts are transmitted **when** a triggering event occurs, such as “you got a mail!”, but not **before** the triggering event occurs.

It is therefore apparent that even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite realistic motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicants, therefore, submit that the imposed rejection of claims 1, 2, 5 through 7, 12 through 17, 27, 28, 34, 38, and 39 under 35 U.S.C. §103(a) for obviousness

based on *Ellis* in view of *Collins* is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 3, 6, 8, 30, 31, 33 (presumably), 35 through 37, 41, and 42 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Ellis* in view of *Collins* and *Haken* (US 2004/0008972, “*Haken*”).

This rejection is traversed.

Independent claims 30, 31, and 42 recite features, such as “scheduling to transmit an alert SMS message to a mobile phone at a time point that has a predetermined time period before the content item of interest being available,” similar to those in independent claim 1. Accordingly, claims 30, 31, and 42 are free of the applied prior art for reasons advocated *supra* in traversing the rejection of independent claim 1 under 35 U.S.C. §103(a) for obviousness based on *Ellis* in view of *Collins*. The additional reference to *Haken* does not cure the previously argued deficiencies in the attempted combination of *Ellis* and *Collins*.

Claims 3, 6 and 8 depend from independent claim 1; claim 41 depends from independent claim 28, and claims 33 and 35 through 37 depend from independent claim 31. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1, 28 and 31 under 35 U.S.C. §103(a) for obviousness predicated upon *Ellis* in view of *Collins*.

Independent claim 30, 31, and 42 further recite, *inter alia* **“when the recording instruction conflicts with a previous recording instruction, converting either the previous recording instruction or the recording instruction into a reminder.”** The Examiner does not appear to have examined the merits of this feature based upon the reasoning that **“if the recording**

instruction conflicts” is in the alternative from thereby met by *Haken* (page 9, lines 19 through 21 of the Office Action). Applicants respectfully submit that the Examiner adopted a double standard in examining the claim recitations beginning with “if.” It appears that the Examiner cherry-picked those “if” recitations that the Examiner could find corresponding teachings in the cited references, and apparently avoided examining the merits of the recitation of “**if** the recording instruction conflicts....”

Since the recitation has been clarified as “**when** the recording instruction conflicts,” the Examiner is required to provide a factual basis to support the obviousness conclusion of this feature. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

Accordingly, even if all of the applied references were combined as proposed by the Examiner, and again Applicants do not agree that the requisite basis for the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*. Applicants, therefore, submit that the imposed rejection of 3, 6, 8, 30, 31, 33, 35 through 37, 41, and 42 under 35 U.S.C. §103(a) for obviousness predicated upon *Ellis* in view of *Collins and Haken* is not factually or legally viable and, hence, solicit withdrawal thereof.

New claims 43 and 44.

New claims 43 and 44 depend from claim 28. Applicants submit that claims 43 and 44 are free of the applied prior art for reasons advocated *supra* with respect to claim 28. Accordingly, claims 43 and 44 are free of the applied prior art.

Based upon the foregoing, it is apparent that the imposed objection and rejections have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 822-7186 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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Date

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